REMARKS

Claims 1-32 are pending in the present application. Claim 3 was canceled. Reconsideration of the claims is respectfully requested.

Amendments were made to the specification to correct errors in compliance with Examiner's requests and to clarify the specification. No new matter has been added by any of the amendments to the specification. The objection to the specification is now believed overcome.

I. 35 U.S.C. § 103, Obviousness

The examiner has rejected claims 1-32 under 35 U.S.C. § 103 as being unpatentable over Herzik et al., USPN 4456969. This rejection is respectfully traversed.

In rejecting claim 1, Examiner states in part:

> Herzik does not explicitly disclose identifying displayable text within the computer source code. However, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Herzik to include identifying displayable text within the computer source code for the following reason. The computer source code received by the computer system for spell checking includes the control codes and the text of the document. Therefore, it is suggested that the system parse the source code to spell check the text only since the control codes are merely the instructions of how to run a spell check process.

Claim 1 is reproduced for purposes of discussion.

> 1. A method in a data processing system for spell checking text, the method comprising:
>
> receiving computer source code for processing;
>
> identifying displayable text within the computer source code; and
>
> checking the displayable text for errors.

1. The cited reference does not teach the claimed limitations of, "identifying displayable text within the computer source code," as claimed in claim 1.

Applicant respectfully submits that the cited reference fails to teach the claimed limitation of, " identifying displayable text within the computer source code," as claimed in claim 1.

The present invention is a system and method for checking spelling of displayable text within computer source code, and includes the recited step of identifying the displayable text within the computer source code. The cited reference, Herzik, addresses a different problem, namely that of identifying the proper language for selecting a spellcheck dictionary with which to perform spellchecking. Applicant finds no teaching or suggestion in Herzik of identifying displayable text within the computer source code.

Herzik instead teaches inserting "control codes" into a document, where the control codes identify the language of the text that follows. This is in order to select the proper spelling dictionary for spellchecking in the proper language. Examiner suggests a modification to Herzik, namely that, because these "control codes" are included in the source code, then "it is suggested that the system parse the source code to spell check the text only since the control codes are merely the instructions of how to run a spell check." (Office action, page 5.)

However, Applicant respectfully submits that the Examiner's suggestion is not anywhere taught or suggested in the cited references. The idea that the control codes of Herzik are within the source code does not make obvious the presently claimed idea of identifying displayable text within the source code. Herzik makes no apparent mention of identifying displayable text. If Applicant has overlooked a relevant teaching, it is respectfully requested that such teaching be pointed out with particularity.

Further, the problem addressed by Herzik differs significantly from that of the present application. Herzik is directed to picking a spellchecking language, and does not discuss source code or displayable text within source code as a target to be identified and spell checked.

Therefore, Applicant respectfully submits that the proposed modification to Herzik suggested by Examiner would not have been obvious to one of ordinary skill in the art at the time of the invention. In determining obviousness, an applicant's teachings may not be read into the prior art. *Panduit Corp. v. Denison Mfg. Co.*, 810 F.2d 1561,

1575 n. 29, 1 U.S.P.Q. 1593, 1602 n. 29 (Fed. Cir. 1987) (citing need to "guard against hindsight and the temptation to read the inventor's teachings into the prior art"). A determination of the desirability of combining prior art references must be made without the benefit of hindsight afforded by an applicant's disclosure. *In re Paulsen*, 30 F.3d 1475, 1482, 31 U.S.P.Q. 1671, 1676 (Fed. Cir. 1994).

2. The cited reference fails to teach or suggest "searching source code for a first delimiter indicative of displayable text," as claimed in claim 9.

Examiner suggests that the Herzik teaches, "inserting instructions in the text at the present operating point to start the spelling verification." However, Applicant respectfully submits that this does not make obvious the claimed limitation of, "searching source code for a first delimiter indicative of displayable text," as claimed in claim 9.

Though Herzik teaches that control codes identify the language of the text that follows, these control codes do not identify displayable text. For example, a computer program could be written in a foreign language, and Herzik's control codes could be inserted to spellcheck the source code in that foreign language. This could include displayable text or non-displayable text. Herzik is silent on whether the spellchecked text is displayable, and is also silent on identifying displayable text.

Examiner suggests modifying the teaching of Herzik, stating on page 7 of the Office action,

> It would have been obvious to one of ordinary skill in the art at the time of the invention was made to have modified to incorporate the searching step and the spellchecking step with the first and second delimiters to start and end the part of text for spell checking for the following reason. The fact that Herzik teaches inserting an instruction in the text *at the present operating point* suggests searching for a *first delimiter* at the present point since it was obvious that each two words in the text and the source code are separated by a space which is a delimiter. Also the fact that *the start point and the end point* in the text are selected to show the part of text where the spellchecking is applied also further suggests a *second delimiter* to end said part of text.

However, even if Applicant were to agree with Examiner on the above statement, Examiner still has not addressed the idea of the delimiters being "indicative of displayable text," as claimed in claim 9. Examiner does not appear to address this important distinction.

Applicant respectfully submits that "inserting instructions in the text at the present operating point to start the spelling verification," and "performing spellchecking until encountering the code to end the spellchecking" as cited by Examiner, even if taught in Herzik, does not teach all limitations of the present invention. Specifically, as argued above, the teaching of Herzik does not address displayable text. For example, the instructions that indicate starting and ending points for spellchecking could include displayable text and non-displayable text. It might include only non-displayable text. Herzik does not address this aspect of spellchecking at all.

Hence, Applicant respectfully submits that Examiner has used the present application as a template in order to suggest this modification to the teaching of Herzik. The mere fact that the prior art could be readily modified to arrive at the claimed invention does not render the claimed invention obvious; the prior art must suggest the desirability of such a modification. *In re Ochiai*, 71 F.3d 1565, 1570, 37 U.S.P.Q.2d 1127, 1131 (Fed. Cir. 1996); *In re Gordon*, 733 F.2d 900, 903, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984). Merely stating that the modification would have been obvious to one of ordinary skill without identifying an incentive or motivation for making the proposed modification is insufficient to establish a *prima facie* case.

Examiner has used the reasoning for claims 1 and 9 to reject all independent claims. Therefore, Applicant respectfully submits that all independent claims are distinguished from the cited reference. Further, several dependent claims are allowable on their own merits. For example, dependent claim 6 states:

> 6. The method of claim 1, wherein the checking step includes:
> selecting a dictionary; and
> spell checking the displayable text using the dictionary.

As argued above, Herzik does not teach or suggest spellchecking the displayable text using the dictionary. Herzik is directed to spellchecking generally, and does not teach or suggest the limitations of claim 6.

Because of their dependence on allowable claims, Applicant respectfully submits that all dependent claims are allowable. Therefore, all claims have been addressed and are believed distinguished from the cited reference. Favorable reconsideration of the claims is respectfully requested.

II. Objection to Claims

The Examiner has stated that claim 3 was objected to because it is a substantial duplicate of claim 2. Claim 3 has been cancelled, and the double patenting rejection is now believed moot.

III. Objection to the Drawings

The Examiner has objected to the drawings, particularly **Figure 4**. The amendments to the specification are believed to obviate this objection, and the drawings are now believed in order.

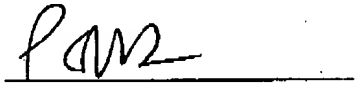
IV. Conclusion

It is respectfully urged that the subject application is patentable over Herzik et al. and is now in condition for allowance.

The Examiner is invited to call the undersigned at the below-listed telephone number if in the opinion of the Examiner such a telephone conference would expedite or aid the prosecution and examination of this application.

DATE: 5.25.04

Respectfully submitted,



Patrick C. R. Holmes
Reg. No. 46,380
Yee & Associates, P.C.
P.O. Box 802333
Dallas, TX 75380
(972) 367-2001
Attorney for Applicants